

REMARKS

This Amendment is being filed in response to the Office Action dated May 22, 2001. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-4 and 6-9 are pending in this application of which Claims 1 and 6 are independent claims.

In the Office Action, Claims 1 and 6 are rejected under 35 U.S.C. §112, second paragraph as being indefinite due to the term "the particular session" having insufficient antecedence basis in the claim. In the interest of placing this application in an acceptable form, this term is amended herein to clarify that the particular session is "the particular session of the video game ..." as now required by each of claims 1 and 6. Further antecedence for this term is found in line 6 for each of Claims 1 and 6. No new matter is added by this amendment nor should this amendment necessitate a further search since this amendment merely clarifies an element already present in the claim, for example, as found in the preamble. Accordingly entrance of this amendment is respectfully requested.

Claims 1-4, and 6-8 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,521,014 to Sitrick ("Sitrick") in view of U.S. Patent No. 4,710,873 to Breslow ("Breslow").

In the Office Action it is stated that Sitrick discloses all the features of Claim 1, except for the feature that the image of the highest-scoring player is shown during play. Breslow is then cited for teaching the display of the highest scorer's image and score. Both the abstract and Fig. 4e of Breslow is cited as support for this feature.

However, neither Sitrick nor Breslow alone or in combination teach "displaying ... the video image of the currently high-scoring player ... during the particular session of the video game ...". This is evident from the description of Figure 4e in the text of Breslow. Specifically, Col 5, lines 39-42 states that (emphasis provided) "After the play of the game ... the play of the game ends with a display of the top six scores as indicated in Fig. 4e". Clearly, this does not teach or suggest anything about showing images or scores during play.

Apparently the provided argument is that the combination of the teachings of Sitrick together with Breslow would give a system in which the highest scorer's image and score is shown during play. This assertion finds no support in either of Sitrick or Breslow. The display of the highest scorer's image in Breslow is in a high score list (Figure 4e). Sitrick shows using a video representation of the player during game play as the player representation in the game.

Item 66 in Figure 4d of Breslow is noted in the Office Action as evidence that the score of the current player is shown during play. The Office Action further states that it is obvious to modify this system to show the image and score of the highest scoring player. However, nowhere within the four corners of either Breslow or Sitrick is there even the hint that would prompt the skilled person to make this modification.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

Sitrick displays images of players during play in order to allow players to distinguish their character from others (column 1, lines 44-49 of Sitrick). In contrast, Breslow shows the high score list to show game results. It is unclear how a combination of these features would result in a gaming system that prominently shows an image of the highest scoring player during play so as to enhance the realism of and competition in the game.

The suggestion that the skilled person would make this modification since it would make the competition more realistic and exciting does not suggest or require this particular modification. In fact, this statement appears to require impermissible hindsight,

since there are many ways to make a game more exciting.

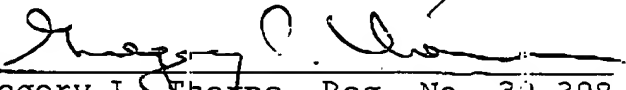
Accordingly, Claims 1 and 6 are patentable over any combination of Sitrick and Breslow. Claims 2-4, and 7-9 depend from one of Claims 1 and 6 and are therefore, also patentable for at least that reason as well as for the separately patentable elements contained in each of the claims.

Based on the foregoing, the Applicants respectfully submit that Claims 1-4 and 6-9 are patentable over the prior art of record and notice to this effect is earnestly solicited.

The Applicant has made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

By   
Gregory L. Thorne, Reg. No. 30,398  
Senior Patent Counsel  
(914) 333-9665  
August 22, 2001

## APPENDIX

1. (Four times amended) A method for operating a multi-player video game, the method comprising:

enabling each player of multiple players to interact with a gaming environment,

machine-detecting a score and/or performance of each player in a particular session of the video game,

backfeeding into the gaming environment a video image of a currently high-scoring player, and

displaying the gaming environment, and the video image of the currently high-scoring player of the multiple players in a prominent location, during the particular session of the video game.

6. (Four times amended) A video game system being arranged for running a multi-player video gaming environment, comprising

a user interface that is configured to enable each player of multiple players to interact with the gaming environment,

a detector that is configured to detect a score and/or performance of each player during a particular session of the video game,

a backfeeding device that is configured to:

backfeed into the gaming environment a video image of a currently high-scoring player of the multiple players, and

a display that is configured to display the gaming environment, and the video image of the currently high-scoring player in a relatively prominent position, during the particular session of the video game, and

one or more cameras that are configured to provide the video image of each player.